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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/340,664 11/16/94 GAUTVIK

18N2/0407

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EXAMINER

KETTER, J

ART UNIT

PAPER NUMBER

4

1805
DATE MAILED:

04/07/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

for restriction purposes only.

☐ This application has been examined ☒ Responsive to communication filed on ☐ This action is made final

A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-6 |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-20 are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Claims 1-20 are pending in the application.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-5, 11, 13 and 15, drawn to purified hPTH, classified in Class 530, subclass 399.

II. Claims 6-8, 12, 14 and 16-20, drawn to KEX2-resistant variants of hPTH, classified in Class 530, subclass 399.

III. Claims 9 and 10, drawn to a recombinant yeast which expresses hPTH, classified in Class 435, subclass 254.2.

The inventions are distinct, each from the other because of the following reasons:

The chemical compositions of Groups I and II are drawn to wild type and mutant forms of hPTH, respectively, the mutant form being resistant to the recited proteases. As such, the invention of Group II encompasses a limitation imparting a particular property. The compositions of Groups I and II are thus distinct, being capable of supporting separate patents.

The recombinant microorganism of Group III, drawn most narrowly to yeast, represents a chemical composition distinct from the hPTH of Group I. The inventions of Groups I and III are thus distinct, capable of supporting separate patents.

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The recombinant microorganism of Group III, drawn most narrowly to yeast, represents a chemical composition distinct from the mutant hPTH of Group II. The inventions of Groups II and III are thus distinct, capable of supporting separate patents.

The search required for the invention of Group I would not entail a search for the limitation, noted supra, distinguishing the invention of Group I from that of Group II. A reference anticipating the invention of Group I would not necessarily anticipate or render obvious the invention of Group II.

The search required for the invention of Group I or II would not necessarily entail a search for recombinant cells. A reference anticipating the invention of Group I or II would not necessarily anticipate or render obvious the invention of Group II.

Because these inventions are distinct for the reasons given above and do not require co-extensive searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Certain papers related to this application may be submitted to Art Unit 1805 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The Art Unit 1805 Fax number is (703) 308-4312. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Ketter whose telephone number is (703) 308-1169. The Examiner

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can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM,
and on alternate Fridays.

If attempts to reach the Examiner are unsuccessful, the
Examiner's supervisor, Dr. Richard Schwartz, can be contacted at
(703) 308-1133.

A handwritten signature in black ink, appearing to read 'J. Ketter', with a long horizontal flourish extending to the right.

James Ketter

April 3, 1995